

REMARKS

The claims stand rejected as anticipated by, or obvious in view of, Rothschild (6,651,053).

It is not evident that Rothschild's disclosure is prior art.

The two independent claims of the present application (1 and 15) both find support back to the May, 1999 provisional application 60/134,782. The specification of the '782 application is attached as Appendix A to the present specification and notes, for example:

A poster, for example, typically includes a photo of the artist, and may comprise cover-art from a CD. The photo/art can be digitally watermarked with various types of data, e.g., the artist's identify, the record label that distributes the artist's work, the music project being particularly promoted by the poster (e.g. a CD, or a concert tour), a fan web-site related to the artist, a web-site hosted by the record label for selling audio in CD or electronic form, a web-site from which free music by the artist can be downloaded, data identifying the poster itself, etc.

A user, equipped with a portable appliance that merges the functions of palmtop computer and digital camera, can snap an image of the poster. The processor can decode the watermarked data, and initiate any of various links based on the decoded data.¹

All of the subject matter detailed in the present specification enjoys priority back to May or June, 1999.

In contrast, Rothschild was filed in August, 2000.

The first paragraph of Rothschild indicates that it claims priority to provisional applications filed in February 2000 and March 2000. It also identifies a January 2000 PCT filing which claims priority back to a February 1999 provisional filing. However, it is not evident what subject matter was included in that February, 1999 filing.

¹ Specification, page 71, lines 16-25.

Moreover, it is not clear that the February 1999 subject matter is available as of that date. The only path back to that provisional application is through a continuity chain that includes an international application (PCT/US00/01885, published as WO 00/45302). Referring to the flow charts found at the end of MPEP § 706.02(f)(1), it appears that the filing of this international application on January 25, 2000 (i.e., before November 29, 2000) means that 102(e) prior art effect dates from the §371(c) date. That date is April 4, 2001 – again long after applicant's priority date.

The PCT application was published on August 3, 2000, so it has a § 102(a) date after applicant's priority date.

If the rejection on Rothschild is renewed, the Examiner is requested to establish that the relied-upon subject matter is actually available as statutory prior art.

In view of the foregoing uncertainty about Rothschild, other points that may be made concerning the art and claims are not belabored.


Date: January 6, 2005

Customer Number 23735

Phone: 503-469-4800
FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By 
William Y. Conwell
Registration No. 31,943